



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,508	04/09/2001	Jack G. Wintercrowd	WEYE117204	6724
26389	7590	12/16/2003	EXAMINER	
CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC			SHOSHO, CALLIE E	
1420 FIFTH AVENUE			ART UNIT	
SUITE 2800			PAPER NUMBER	
SEATTLE, WA 98101-2347			1714	

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/829,508	Applicant(s) WINTEROWD, JACK G.	
	Examiner Callie E. Shosho	Art Unit 1714	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☒ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-6, 9-13, 15-22 and 24-28.

Claim(s) withdrawn from consideration: 29 and 30.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Callie E. Shosho
Primary Examiner
Art Unit: 1714

Attachment to Advisory Action

1. Applicants' amendment filed 11/14/03 has been considered but it has not been entered given that it raises the issue of new matter.

Specifically, claims 1 and 24 have been amended to recite that the debonding agent is present in an amount of from "about 17 to about 50%" based on the total weight of the composition. Further, newly added claim 31 also recites the same claim language. However, it is the examiner's position that this phrase fails to satisfy the written description requirement under 35 USC 112, 1st paragraph since there does not appear to be a written description requirement of the lower limit of the debonding agent, i.e. 17%, in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

As support for the recitation of the lower limit of the amount of debonding agent, applicants point to the example found in the specification and state that the amount, i.e. 17%, is based on the weight percent of soybean oil in the paint.

However, the amount of 17% is based on the amount of soybean oil in the paint while the present claims recite that the debonding agent is present in an amount of "about 17 to about 50%". This is significant given that the present claims recite that the debonding agent "comprises" vegetable oil. That is, the debonding agent comprises other ingredients, one of which is soybean oil. From the example, it appears that the debonding agent is present in an amount of 21%.

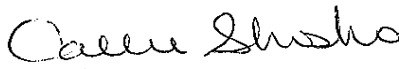
Thus, while there is support in the present specification for the recitation that the soybean oil is present in an amount of 17%, there is no support for the recitation that the debonding agent is present in an amount of 17%.

NOTE: If applicants were to amend claims 1 and 24 to recite that the debonding agent is present in an amount of "21 to about 50%", such amendment would overcome the prior art rejections of record given that there is no disclosure in either Kang et al. (U.S. 3,894,976) or Coleman (U.S. 3,959,224) of debonding agent present in such an amount.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Callie E. Shosho
Primary Examiner
Art Unit 1714